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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,444	04/06/2001	Curt V. Avallone	55,279 (20786)	6897

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EXAMINER

BACKER, FIRMIN

ART UNIT PAPER NUMBER

3621

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/828,444

Applicant(s)

AVALLONE ET AL.

Examiner

Firmin Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 30-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 30-43 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

This is in response to an amendment file on October 10<sup>th</sup>, 2003 for letter for patent filed on April 6<sup>th</sup>, 2001 in which claims 1-43 were presented for examination. In the amendment, claims 30-43 have been canceled. Claims 1-29 remain pending in the letter.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 23-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” and therefore are found to be non-statutory subject matter. For a method claim to pass the muster, the recited method must somehow apply, involve, use, or advance the technological arts.

In the present case the inventive concept in claim 23 only recites an abstract idea. The recited step providing at least on database of personalized information transmitting personalized

information ... etc. do not apply, involve, use or advance the technological arts since all the steps can be performed in the mind of the user or by use of pencil and paper and no specific technology (e.g. computer, processor) is expressly recited in the body of the claims. *In re Toma (CCPA 197 USPQ 852 (1978))*.

2. Although the recited method produces a useful, concrete and tangible result, since the claimed invention, as a whole, it not within the technological arts as explained above, claim 23 deemed to be directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-7 and 23-29 are rejected under 35 U.S.C. 102(e) as being anticipate by Herz et al (U.S. PG Pub 2001/0014868 A1 (*applicant admitted prior art*)).

5. As per claims 1, 23 and 24 Herz et al teach a system/method for providing to at least one user in a commercial establishment personalized information relevant to the commercial establishment, the system comprising: at least one database comprising the personalized information; at least one transmitter for transmitting the personalized information to a user;

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and at least one receiver for receiving, storing, and displaying the personalized information to the user (*see fig 1, paragraphs 0021, 0022, 0024*).

6. As per claims 2-4, Herz et al teach a system wherein the personalized information is derived from the user's past purchases, shopping list, is derived from the user's demographic profile (*see paragraph 0024*).

7. As per claims 5-7, Herz et al teach a system for accessing the personalized information from the at least one database comprises a personal identification number and associated passphrase, loyalty card that is input into a portable display unit (*see paragraph 0024*).

8. As per claim 27, Herz et al teach a method wherein the method further comprises accessing personalized information from the at least one database and determining associated personalized information to transmit based on the at least one user's calculated precise location (*see fig 1, paragraphs 0021, 0022, 0024*).

9. As per claims 28, 29, Herz et al teach a method wherein accessing personalized information includes authenticating a loyalty card, wherein the loyalty card is input into a portable display unit by the at least one user, authenticating a personal identification number and associated password, wherein the personal identification number and associated password are input into a portable display unit by the at least one user (*see fig 1, paragraphs 0021, 0022, 0024*).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 8-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz et al (U.S. PG Pub 2001/0014868 A1 (*applicant admitted prior art*) in view of Fenton et al (U.S. PG Pub 2002/0035840 A1).

12. As per claim 8, Herz et al teach a system for providing personalized information to a user in a commercial establishment, comprising least one database comprising personalized information, at least one transmitter for transmitting the personalized information to the user; and at least one receiver for receiving, storing, and displaying personalized information, wherein the at least one transmitter is in communication with the location tracking system and the location tracking system is in communication with the receiver. (*see fig 1, paragraphs 0021, 0022, 0024*). Herz et al fail to teach a location tracking system and a transmitter is in communication with the location tracking system and the location tracking system is in communication with the receiver. However, Fenton et al teach a location tracking system and a transmitter is in communication with the location tracking system and the location tracking system is in communication with the receiver (*see abstract, figs 1,2 paragraphs 0009, 0012*). Therefore, it would have been obvious to one of ordinary skill in

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the art at the time the invention was made to modify Herz et al's inventive concept to include Fenton et al's location tracking system and a transmitter is in communication with the location tracking system and the location tracking system is in communication with the receiver because this would have the collection of valuable information and thus make proper user of the available location information.

13. As per claim 9, Herz et al teach a system wherein the personalized information is at least one selected from a group comprising targeted advertisements, health information, nutritional information, promotional offers, offers on sale items, offers on discounted items, information on similar or associated items, manufacturer's coupons, storewide coupons, information on user specific favorite items, and information on user specific staple items (*see fig 1, paragraphs 0021, 0022, 0024*).

14. As per claims 10-12, 25 and 26 Fenton et al teach a system wherein the personalized information is provided based on a user's precise location with respect to the commercial establishment, wherein the user's precise location has been calculated by the location tracking system comprises transmitter for transmitting position data relating to at least one portable display unit, receiver for receiving position data relating to the at least one portable display unit; and a position calculating system for calculating the precise location of the at least one portable display unit with respect to the commercial facility using position data therefrom and by at least one of biangulation or triangulation (*see abstract, figs 1,2 paragraphs 0005, 0009, 0012*).

15. As per claim 13, 14, Fenton et al teach a system wherein position data includes a radio frequency (RF) identification signal, an infrared identification signal (*see abstract, figs 1,2 paragraphs 00019*).

16. As per claim 15, 16, Herz et al teach a system wherein the at least one receiver includes a plurality of transceivers located at discrete locations throughout the commercial establishment, a plurality of transponders located discrete locations throughout the commercial establishment (*see paragraph 0021*).

17. As per claim 17, Herz et al teach a system wherein the means for transmitting personalized information to the user comprises a wireless local area net (*see paragraph 0021-0024*).

18. As per claim 18, Herz et al teach a system wherein the at least one receiver comprises at least one transceiver that is in communication with a portable display unit (*see paragraph 0021-0024*).

19. As per claim 19, Herz et al teach a system wherein the portable display unit includes at least one database, a user interface, a display screen, and associated software to allow the portable display unit to receive, store, and display personalized information in a format that is readable by humans (*see paragraph 0021-0024*).



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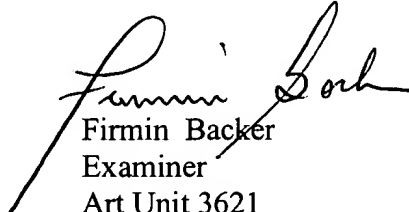
20. As per claim 20-22, Herz et al teach a system further comprising a means for accessing the personalized information comprises a personal identification number and associated password that are input into a portable display unit, a loyalty card that is input into a portable display unit (*see paragraph 0021-0024*).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
Firmin Backer  
Examiner  
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November 10, 2003